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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/485,903 03/31/00 DUPUIS

C 05725.0532

EXAMINER

HM12/0730

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GARRETT & DUNNER
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WASHINGTON DC 20005

WELLS, J

ART UNIT

PAPER NUMBER

1619

DATE MAILED:

07/30/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

| | | | |
|------------------------------|-------------------------------|-------------------------------|--|
| Office Action Summary | Application No. 09/485,903 | Applicant(s) DUPUIS ET AL. | |
| | Examiner Lauren Q Wells | Art Unit 1619 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2001.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- | | |
|---|--|
| 15) <input type="checkbox"/> Notice of References Cited (PTO-892) | 18) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 16) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 19) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 17) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 20) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Response to Arguments***

The Applicant's arguments filed May 30, 2001 (Paper No. 9) to the rejection of claims 18-45 made by the Examiner under 35 USC 102 (b) and 103 (a) have been fully considered and deemed not persuasive. The Applicant's arguments filed May 30, 2001 (Paper No. 9) to the rejection of claims 19-21, 23-34, 29 and 34 made by the Examiner under 35 USC 112 have been fully considered and deemed persuasive. Thus, the rejection in regard to improper Markush groups and insufficient antecedent basis is withdrawn. However it is noted that the phrase "selected from" in comparison to the phrase "chosen from" is the preferred Markush language.

102 Rejection Maintained

The rejection of claims 18-21, 24-31, 35-36, 39, and 40-45 under 35 U.S.C. 102 (b) as being unpatentable over Dubief et al. (WO 9221316) is MAINTAINED for the reasons set forth in the Office Action mailed January 30, 2001, Paper No. 7, and those found below.

Applicant argues that the reference does not teach that the dimethiconol is present as an emulsion. This argument is not persuasive, as claim 1 of Dubief et al. teach a composition comprising an aqueous dispersion and an emulsion and example 1 of Dubief et al. (Col. 8, lines 10-28) teaches a composition comprising a mixture of octamethylcyclotetrasiloxane dimethiconol (dimethiconol is a non-aminated silicone disilanol) and dodecamethylcyclopentasiloxane, an aqueous dispersion of vinyl polyacetate, and an emulsion of crosslinked ammonium acrylate/acrylamide copolymer, preservative, HCL acid, and water. Thus, the dimethiconol is in a composition comprising an emulsion. Furthermore, it is noted that a) dodecamethylcyclopentasiloxane, which is in mixture with the dimethiconol, is an oil; and

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b)water is a constituent of the composition. Therefore, the Examiner respectfully points out that dimethiconol is present as part of an emulsion.

103 Rejection Maintained

The rejection of claims 18-39 under 35 U.S.C. 103 (a) as being unpatentable over Dubief et al. (WO 9221316) in view of Blankenburg et al. (6,153,179) and Audousset et al. (6,106,577) is MAINTAINED for the reasons set forth in the Office Action mailed January 30, 2001, Paper No. 7, and those found below.

Applicant argues that the references do not teach that the dimethiconol is present as an emulsion. This argument is not persuasive, as claim 1 of Dubief et al. teach a composition comprising an aqueous dispersion and an emulsion and example 1 of Dubief et al. (Col. 8, lines 10-28) teaches a composition comprising a mixture of octamethylcyclotetrasiloxane dimethiconol (dimethiconol is a non-aminated silicone disilanol) and dodecamethylcyclopentasiloxane, an aqueous dispersion of vinyl polyacetate, and an emulsion of crosslinked ammonium acrylate/acrylamide copolymer, preservative, HCL acid, and water. Thus, the dimethiconol is in a composition comprising an emulsion. Furthermore, it is noted that a)dodecamethylcyclopentasiloxane, which is in mixture with the dimethiconol, is an oil; and b)water is a constituent of the composition. Therefore, the Examiner respectfully points out that dimethiconol is present as part of an emulsion.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on M-F (7-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diana L Dudash can be reached on (703) 308-2328. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

lqw
July 3, 2001


DAMERONT L. JONES
PRIMARY EXAMINER